

REMARKS

STATUS OF CLAIMS

Claims 38, 46, 54-57, 66-71, 82-87, 89-93, 108-110, 119, 124, 126-128 and 131-174 are pending in the present application. Claims 38, 46, 54-57, 66-71, 82-87, 89-93, 108-110, 119, 124, 126-128 and 131-174 are rejected. Claims 1-37, 39-45, 47-53, 58-65, 72-81, 88, 94-107, 111-118, 120-123, 125, 129, 130 have been cancelled.

By virtue of this response, claims 46, 67, 83, 89-91, 110, 131-133, 137, 166 and 169 have been amended. After entry of these amendments, claims 38, 46, 54-57, 66-71, 82-87, 89-93, 108-110, 119, 124, 126-128 and 131-174 will be pending.

With respect to all amendments, Applicants have not dedicated or abandoned any unclaimed subject matter and moreover have not acquiesced to any rejections and/or objections made by the patent office. Applicants reserve the right to pursue prosecution of any presently excluded claim embodiments in future continuation and/or divisional application.

PETITION TO CORRECT INVENTORSHIP

Applicants note that a Petition to Correct Inventorship pursuant to 37 C.F.R. § 1.48(a) and an accompanying Petition for Suspension of Rules pursuant to 37 C.F.R. § 1.183 is submitted concurrently herewith.

CLAIM AMENDMENTS

Claims 46, 67, 83, 89-91, 110, 131-133, 137, 166 and 169 have been amended. Claims 46, 67 and 83 have been amended to recite one or more optional linker moiety. Claims 89 and 131 have been amended to recite "said valency platform molecules." Claims 91 and 133 have been amended to remove redundant language. Claims 90, 132 and 137 have been amended to indicate that the bond is a modified oxime bond. Claims 110, 166 and 169 have been amended to reflect new claim dependencies.

All claim amendments are fully supported by the specification as filed and do not constitute new matter.

REJECTIONS UNDER 35 USC § 112, SECOND PARAGRAPH

Claims 38, 46, 54-57, 66-71, 82-87, 89-93, 108-110, 119, 124, 126-128, and 131-174 are rejected under 35 USC § 112, second paragraph, as allegedly indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicants respectfully traverse the rejection of claims 38, 46, 54-57, 66-71, 82-87, 89-93, 108-110, 119, 124, 126-128, 131-174 and address the 35 USC § 112, second paragraph claim rejections in the remarks below.

REJECTION OF PREVIOUSLY ALLOWED CLAIMS

MPEP sections 706.04 and 1308.01 set forth Patent Office policy regarding rejection of previously allowed claims. MPEP § 706.04 states, "A claim noted as allowable shall thereafter be rejected only with the approval of the primary examiner. Great care should be exercised in authorizing such a rejection . . . because it is unusual to reject a previously allowed claim, the examiner should point out in his or her office action that the claim now being rejected was previously allowed."

The U.S. Patent and Trademark Office allowed claims 38, 46, 54-57, 66-71, 82-87, 89-93, 108-110, 119, 124 and 126-128 in the Office Action dated August 21, 2003 (Paper No. 23). The U.S. Patent and Trademark office allowed claims 38, 46, 54-57, 66-71, 82-87, 119, 124, 126-128 a second time and allowed claims 136-140 and 147-162 in the Office Action dated June 16, 2004.

Applicants submitted amendments to claims 38, 66, 67, 82, 83, 91, 92, 108-110, 133, 134, 138, 139, and 141-146 on September 16, 2004. The remaining previously allowed claims have not been amended since their indication as allowable. The present claim rejections are not based on Applicants' September 16, 2004 amendments. Rather, the majority of the present claim rejections are 35 U.S.C. § 112 second paragraph rejections based on claim language previously allowed by the U.S. Patent and Trademark Office.

The present rejection of previously allowed claims is contrary to U.S. Patent Office practice because the Patent Office is taking an entirely new approach to the acceptability of Applicants' claim language, especially with regard to Applicants' use of the claim term "about" in reference to a numerical range. In addition, no reasoning is provided in the Office Action regarding why previously allowed claim language is currently rejected. For these reasons, Applicants respectfully request withdrawal of the rejection of previously allowed claims 38, 46, 54-57, 66-71, 82-87, 89-93, 108-110, 119, 124, 126-128, 136-140 and 147-162 and reinstatement of their allowance. Applicants further address the 35 U.S.C. § 112 second paragraph rejections below.

REJECTION OF CLAIMS FOR WHICH NO PARTICULAR REJECTION IS MADE

The Office Action Summary and page 2 of the outstanding Office Action indicate that claims 38, 46, 54-56, 66-71, 90-93, 109-110, 119, 124, 126-128, 132-140, 142, 143, 145-147, 149, 151-167, 169 and 172-174 are rejected. However, the Office Action does not provide an explanation for the 35 U.S.C. § 112 second paragraph rejection of claims 38, 46, 54-56, 66-71, 90-93, 109-110, 119, 124, 126-128, 132-140, 142, 143, 145-147, 149, 151-167, 169, and 172-174. Examiner Lukton kindly confirmed during a telephone conversation with Applicants' representatives on February 23, 2005 that an acceptable response to the present Office Action rejections, in which claims are listed as rejected but for which no particular rejection is made, is to list such claims in Applicants' response. By this paragraph, Applicants are meeting the requirement for responding to the rejection of claims 38, 46, 54-56, 66-71, 90-93, 109-110, 119, 124, 126-128, 132-140, 142, 143, 145-147, 149, 151-167, 169, and 172-174. Applicants assert that these claims comply with the requirements of 35 U.S.C. § 112 second paragraph and respectfully request withdrawal of their rejection.

SPECIFIC REJECTIONS UNDER 35 U.S.C. § 112, SECOND PARAGRAPH

The Office Action provides an explanation regarding the rejection of claims 57, 82, 87, 89, 108, 131, 141, 144, 148, 150, 168 and 170-171. Arguments regarding the rejection of these claims

are presented below in the same order in which the claim rejections are discussed in the outstanding Office Action.

Claim 82

The Patent Office allowed claim 82 in the Office Action dated 8/21/2003 (Paper No. 23). The Patent Office again allowed claim 82 in the Office Action dated 06/16/04. Applicants' September 16, 2004 amendment to claim 82 is not the basis for the present rejection of claim 82. Applicants respectfully request reinstatement of the allowance of claim 82 based on Patent Office practice regarding rejection of previously allowed claims. MPEP § 706.04. In the event that the allowance of claim 82 is not reinstated based on the comments above, Applicants assert that the 35 U.S.C. § 112 second paragraph should be withdrawn based on the arguments provided below.

Claim 82 is rejected under 35 USC § 112, second paragraph, as allegedly indefinite for the recitation of the phrase "n is about 200 to about 500." The Office Action alleges that the phrase "n is about 200 to about 500" renders the claim indefinite as to the upper and lower limits of the range. Applicants respectfully traverse the 35 USC § 112, second paragraph rejection of claim 82.

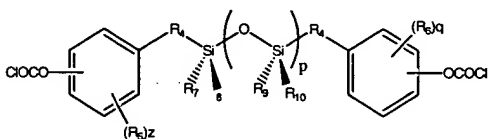
The term "about" in a claim does not *ipso facto* render the claim indefinite if one skilled in the art would understand what is claimed in light of the specification. MPEP § 2173.05(b). The fact that claim language may not be precise does not automatically render a claim indefinite under 35 USC § 112, second paragraph. In fact, the claim term "about", e.g., when used to define the area of the lower end of a mold as a range of between 25 to about 45% of the mold entrance has been held to be clear, but flexible. *Id.* The Patent Office consistently allows claims reciting the term "about" and "the propriety of the use of the expression "about" in claims to permit "of some tolerance" is established by long practice in the Patent Office." *Ex parte King*, 82 U.S.P.Q. (BNA) 450 (BdPatApp&Int 1948).

A search of the U.S. Patent and Trademark Office database on December 23, 2004 revealed that the Patent Office issued 727,650 patents having at least one claim with the word "about." In addition, the Patent Office has recently issued several patents wherein the term "about" is used in a manner similar to how it is used in presently rejected claim 82, that is, in the recitation of a numerical range.

For example, the Patent Office issued U.S. Patent No. 6,833,422 on 12/21/04. Claim 8 of U.S. Patent No. 6,833,422 recites the term “about” in reference to a numerical range indicating the size of a chemical moiety. Similarly, the Patent Office issued U.S. Patent No. 6,824,766 on 11/30/04, in which claim 2 recites the term “about” in reference to a numerical range indicating the size of a chemical moiety. To illustrate the similarities between claims in recently issued U.S. patents and the presently rejected claim, Applicants have listed claim 8 of U.S. Patent No. 6,833,422 and claim 2 of U.S. Patent No. 6,824,766 below on the left and presently rejected claim 82 below on the right, with the “about” phrase of each claim highlighted by bold text.

2. The compound of claim 1 wherein R¹ is O(CH₂CH₂O)_x or O(CH(CH₃)CH₂O)_x, wherein X is from **about 10 to about 2,300**.

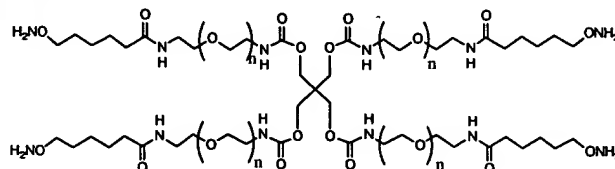
8. A method according to claim 1 wherein said diloxane bischloroformate comprises structure II



wherein . . .

p is an integer **from 1 to about 100**.

Claim 82 (previously presented): A valency platform molecule having the formula:



or an aminoxy protected form thereof, wherein n is **about 200 to about 500**.

U.S. Patent Nos. 6,833,422 and 6,824,766 contain claims that recite “about” in the same manner in which “about” is recited in presently rejected claim 82 because “about” is used in the recitation of a numerical range indicating the size of a chemical moiety in a molecule. The recitation of a numerical range indicating the size of a chemical moiety is analogous to the area range held to be clear, but flexible in *Ex parte Eastwood*. MPEP 2173.05(b). Issued claims 2 and 8 from U.S. Patent Nos. 6,833,422 and 6,824,766, respectively, are additional evidence that the Patent Office does not find the mere recitation of the term “about” in reference to a numerical range indefinite under 35 USC § 112, second paragraph.

Further evidence that the Patent Office, and Technology Center 1600 in particular, continues to allow claims reciting the term “about” in reference to a numerical range can be found in several recently issued patents for which Examiner Weber signed the Notice of Allowability as Supervisory Examiner. Examiner Weber is the Supervisory Patent Examiner for the present application.

For instance, the Patent Office issued U.S. Patent No. 6,879,711 on 2/1/05, with claim 6 reciting in part “a molecular weight in the range from **about 3,000 daltons to about 100,000 daltons.**” Similarly, U.S. Patent No. 6,846,299 issued on 1/25/05, with claim 1 reciting in part, “albumin in an amount of **about 20 to about 250 g/L.**” The Patent Office issued U.S. Patent 6,838,431 on 1/4/05 in which claim 1 recites in part, “an amount of an extract of potato, soy, or beans containing a proteinase inhibitor to provide from **about 0.16 to about 0.63** weight percent of the proteinase inhibitor.” The Patent Office issued U.S. Patent No. 6,821,752 on 11/23/04, in which in claims 5, 7, 9, 13 and 15 recite the term “about” in reference to a numerical range of temperature, pH, time, concentration and percentage, respectively. For instance, claim 5 of U.S. Patent No. 6,821,752 recites, “the method of claim 1, further comprising the step of incubating the host cells at a temperature of **between about 2° C and about 50° C.**” Examiner Weber signed the Notice of Allowability as the Supervisory Patent Examiner for each of the patents noted above. Copies of the signed Notices of Allowability are attached to this Response to Non-Final Office Action as Appendix A.

As evidenced by the claims noted above, the Patent Office continues to issue patents whose claims recite the term “about” in reference to a numerical range. The Patent Office therefore does not find that the recitation of the term “about” in reference to a numerical range *ipso facto* renders a claim indefinite as to the upper and lower limits of the range.

In presently rejected claim 82, the phrase “n is about 200 to about 500” does not render the claim indefinite as to the upper and lower limits of the range because a person of ordinary skill in the art would understand what is claimed, in light of the specification. The Patent Office allowed claim 82 in the Office Actions dated August 21, 2003 and June 16, 2004, which provides additional support to Applicants’ assertion that claim 82 is clear and meets the requirements of 35 U.S.C. § 112 second paragraph.

In view of the above arguments and remarks, Applicants respectfully request withdrawal of the rejection of claim 82 under 35 U.S.C. § 112 second paragraph.

Claims 89 and 131

Claims 89 and 131 are rejected under 35 U.S.C. § 112 second paragraph as allegedly indefinite for the recitation *a* valency platform molecule, and not the particular valency platform molecules of claims 38 and 66, respectively. Applicants have amended claims 89 and 131 to recite “said valency platform molecule.” The claims as amended explicitly refer to the valency platform molecules of claims 38 and 66, as suggested on page 3 of the Office Action. Applicants respectfully request withdrawal of the 35 U.S.C. § 112 second paragraph rejection of claims 89 and 131.

Claims 108, 141, 144, 87 and 57

The U.S. Patent and Trademark Office allowed claims 57 and 87 in the Office Action dated August 21, 2003 (Paper No. 23). Claims 57 and 87 were allowed a second time in the Office Action dated June 16, 2004. Applicants’ amendments to claims 57 and 87 are not the basis for the present rejection. Applicants respectfully request reinstatement of the allowance of claims 57 and 87 and further address the present rejections in the comments below.

Claims 108, 141, 144, 87 and 57 are rejected under 35 U.S.C. § 112 second paragraph as allegedly indefinite for the recitation of linker moieties, which are not recited in the claims from which the rejected claims depend. The Office Action states that the claim dependence of claims 108, 141, 144, 87 and 57 are therefore not proper and offers the suggestion of reciting the optional presence of linker moieties in the claims from which the rejected claims depend. Applicants respectfully traverse the rejection of claims 108, 141, 144, 87 and 57 on the grounds that the dependence of claims 108, 141, 144, 87 and 57 is proper because the recitation of linker moieties is the additional limitation that renders claims 108, 141, 144, 87 and 57 narrower than the claims from which they depend.

However, in order to expedite prosecution, Applicants have implemented the amendment suggested by the Examiner on page 3 of the Office Action by amending claims 46, 67, and 83 to recite the optional presence of a linker moiety. In view of the arguments and amendments

presented, Applicants respectfully request withdrawal of the 35 U.S.C. § 112 second paragraph rejection of claims 108, 141, 144, 87 and 57.

Claim 170

Claim 170 is rejected under 35 U.S.C. § 112 second paragraph as allegedly indefinite for the recitation of the phrase “**between about 1.05 and 1.2.**” In response, Applicants refer the Examiner to the comments above under the heading “Claim 82” regarding the usage of the claim term “about” in the recitation of a numerical range. In addition, a search of the U.S. Patent and Trademark database on December 28, 2004 revealed 66,423 issued patents with at least one claim reciting the phrase “between about.” One such patent, U.S. Patent No. 6,767,566 issued 7/27/04 with claim 4 reciting in part, “the sodium chloride normality is **between about 0.8 and 1.5.**” Clearly, the Patent Office continues to allow claims that recite the phrase “between about” in reference to a numerical range. The recitation of “between about 1.05 and 1.2” in claim 170 does not render the claim indefinite because one skilled in the art would understand what is claimed in view of the specification, which is the appropriate standard for determining compliance with 35 U.S.C. § 112 second paragraph. MPEP 2173.05(b). Accordingly, Applicants respectfully request withdrawal of the 35 U.S.C. § 112 second paragraph rejection of claim 170.

Claim 148

The U.S. Patent and Trademark Office found presently rejected claim 148 allowable in the Office Action dated June 16, 2004. Applicants have not amended claim 148 since its allowance. Applicants respectfully request reinstatement of the allowance of claim 148 and provide the following comments regarding the present rejection.

Claim 148 is rejected under 35 U.S.C. § 112 second paragraph as allegedly indefinite for the recitation of the phrase “less than about.” Applicants assert that the recitation of “less than about” in claim 148 does not render the claim indefinite because one skilled in the art would understand what is claimed in view of the specification. Applicants refer the Examiner to the comments above under the heading “Claim 82” regarding the usage of the phrase “about.” In addition, a search of the U.S. Patent and Trademark database on December 28, 2004 revealed 45,120 issued patents with

at least one claim reciting the phrase “less than about.” One such patent, 6,599,631, issued 7/29/03 with claim 25 which recites “The composite composition of claim 17 wherein the inorganic particles have an average particle size **less than about 500 nm.**” Clearly, the U.S. Patent and Trademark Office continues to allow claims reciting the same phrase which forms the basis for the present rejection of claim 148. Applicants respectfully request withdrawal of the 35 U.S.C. § 112 second paragraph rejection of claim 148 and reinstatement of its allowance.

Claim 168

Claim 168 is rejected under 35 U.S.C. § 112 second paragraph as allegedly indefinite for the recitation of amino groups when referring to groups of the formula “ONH₂.” In response, Applicants have amended claim 168 to recite “aminooxy” in place of “amino.” In view of this amendment, Applicants respectfully request withdrawal of the 35 U.S.C. § 112 second paragraph rejection of claim 168.

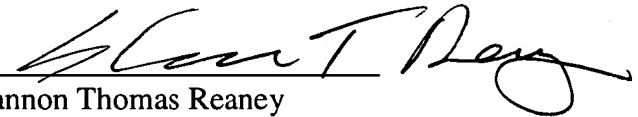
CONCLUSION

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. If it is determined that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

In the event the U.S. Patent and Trademark office determines that an extension and/or other relief is required, applicants petitions for any required relief including extensions of time and authorize the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. **03-1952** referencing docket no. **252312007300**. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

Dated: March 10, 2005

Respectfully submitted,

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